

Claim Rejections

Pending Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shear, U.S. Patent No. 5,410,598 (“Shear”), in view of Peters, WO 02/097705 (“Peters”). Applicants respectfully traverse this rejection.

Peters. Regarding the Peters reference, Applicants note that the international filing date (April 30, 2002), the international publication date (December 5, 2002), and the original U.S. filing dates (April 30, 2001 and August 27, 2001) of Peters are all *after* the U.S. filing date of the present application (April 10, 2001). Applicants therefore submit that with respect to the present application, Peters is not a prior art reference under any section of 35 U.S.C. § 102.

Shear. As previously submitted in Applicants’ Response under 35 U.S.C. § 1.111 of October 25, 2004, Shear fails to teach or suggest each of the limitations of the present invention as recited in the claims.

As in the previous Office Action of July 28, 2004, the Examiner acknowledges that Shear fails to teach or suggest a design database, as claimed, containing information on sample circuits, as recited in independent Claims 1, 7, and 13. (Office Action, p. 4). Further, Applicants submit that Shear fails to teach or suggest a designer terminal for a designer to search such a design database and conduct the design of a device.

Regarding these deficiencies of Shear, as in the July 28 Office Action, the Examiner again asserts that “these differences are found only in the non-functional data stored in the database,” and that “this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability,” under *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ 1031 (Fed. Cir. 1994). (Office Action, p. 5).

Applicants again submit that the Federal Circuit's opinions in *Gulack* and *Lowry* do not support the Examiner's position, and further that the Federal Circuit specifically supports that patentable weight is to be given to claim limitations such as the presently-claimed limitations discussed above.

In *Gulack*, the Federal Circuit held that "where printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *Gulack*, at 1385. However, in its opinion in *Lowry*, the Federal Circuit first notes that in *Gulack*, the court "cautioned against a liberal use of 'printed matter rejections' under section 103." *Lowry* at 1583. Additionally, the *Lowry* court distinguishes the facts of *Gulack* from a situation involving information stored in memory, where "the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer." *Lowry*, at 1583. The *Lowry* court goes on to emphasize that "the printed matter cases have no factual relevance here," referring to claims, such as those of the present invention, which recite databases which store information to be utilized by computer applications. *Id.*

Therefore, Applicants respectfully request that the Examiner give patentable weight to the above-discussed limitations, which the Examiner has *twice* acknowledged are not taught in the Shear reference.

Furthermore, regarding Claims 1 and 7, Applicants submit that Shear fails to teach or suggest an account terminal, as claimed, for making a payment from a bank account of a designer. The Examiner refers to col. 3, ln. 60 to col. 4, ln. 60 of Shear as teaching this limitation. (Office Action, p. 2 and 4). However, contrary to the assertion of the Examiner,

neither the cited portion, nor any other portion of Shear teaches or suggests an account terminal for making a payment from a bank account of a designer, as claimed. In contrast, the system of Shear discloses a central billing facility which receives information regarding charges to be billed to a database user and bills the user. There is no teaching or suggestion of an account terminal which makes a payment from the bank account of a user, as claimed.

Therefore, for at least the above reasons, Applicants submits that Claims 1, 7, and 13 are patentable over Shear.

Applicants submit that Claims 2-6, 8-12, and 14-27 are patentable at least by virtue of their dependence on Claims 1, 7, and 13, and for the following additional reasons.

Regarding Claims 2, 8, and 14, Shear fails to teach or suggest a design database searchable on a world wide web (WWW) site, as claimed. Shear fails to specifically discuss any database searchable through a WWW site, and Shear teaches away from the use of remote centralized databases only accessible to a user through telephone lines or other communication means. Shear specifically discusses a number of “important disadvantages” of such databases. (Col. 2, lns. 20-43).

Regarding Claims 3, 9, 21, and 24 Shear fails to teach or suggest paying a fee from the bank account of one party to the bank account of another party, as claimed. As discussed above with respect to Claims 1 and 7 there is no teaching or suggestion in Shear of an account terminal making a payment from a bank account of a designer. Likewise, Shear fails to teach or suggest an account terminal paying a fee from a bank account of one party to a bank account of another party, as claimed.

Regarding Claims 4, 6, 10, 12, 15, and 17, Shear fails to teach or suggest notifying designer terminals if a problem is found in a sample circuit during the design process. In other words, Shear fails to teach or suggest notifying user terminals of problems found in data stored in a database on a remote server. Shear fails to describe a problem being found with information stored in a database. Shear also fails to teach or suggest notifying a user terminal of problems found in data stored in a database.

Regarding Claims 5, 6, 11, 12, 16, and 17, Shear fails to teach or suggest conducting circuit design or determining parts to employ through price simulation and noise simulation, as claimed.

Regarding Claims 18-20, 22, 23, and 25-27 Shear fails to teach or suggest a database comprising any of information on an anti-noise circuit, information on parts and vendors that supply the parts, or information on sample circuits, registered by a parts vendor, as claimed.

Therefore, in view of at least the above, and further in view of the detailed arguments presented in Applicants' October 25 Response, Applicants respectfully request that the Examiner's §103(a) rejection of Claims 1-27 be reconsidered and withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/828,889

Q63958

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